

**REMARKS**

Claims 1-24 and 26 are pending in the present application. Claims 1-5, 8, 10-15, and 26 stand rejected under 35 U.S.C. §102(b) as being anticipated by Von Kohorn. Claims 6-7, 9 and 16-24 stand rejected under 35 U.S.C. 103(a) over Von Kohorn in view of Official Notice. Applicants respectfully traverse, but have amended the claims to further clarify the distinctions between the invention and the Von Kohorn reference. These amendments are discussed below in the Response to Arguments section.

**Nature of The Present Invention**

The present invention is aimed at the need to measure and improve the *effectiveness* of advertisers' ads in the context of the programs in which they are aired and to obtain accurate, continuous data on the *performance* of ads. Independent claim 1 is directed to a method of increasing the effectiveness of advertising using first and second sets of questions relating to advertising content and show content, respectively. Independent claim 12 is directed to a method of using a user's demographic profile to conduct a trivia contest using such first and second sets of questions. Independent claim 14 is directed to a method of determining advertising performance using such first and second sets of questions. Independent claim 15 is directed to a method of determining the effectiveness of product placement based upon members' answers to first and second subsets of questions. Independent claim 16 is directed to a method of creating a report indicative of the effectiveness of advertising content using such first and second sets of questions. Independent claim 20 is directed to a method of increasing the effectiveness of advertising content, determining advertising content performance, and

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determining show content performance, using such first and second sets of questions.

Independent claim 21 is directed to a method of creating a report indicative of recall, understanding, likeability or other broadcast performance measure, using such first and second sets of questions.

**The Claimed Invention Is Patentable Over Von Kohorn**

Claims 1-5, 8, 10-15 and 26 stand are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,759,101 to Von Kohorn (hereinafter “Von Kohorn”). Applicants respectfully traverse the rejections in their entirety.

**The System Disclosed by Von Kohorn**

Von Kohorn discloses a system which allows external participants to participate in a broadcast, e.g., a game show or a sporting event such as a football game. See, e.g., col. 3, lines 36-44; col. 23, lines 8-55. Questions are presented in the broadcasted show by the show’s host or sportscaster, or are projected onto an on-stage screen which is in view of the television camera. Remote audience members and/or live audience members enter their responses to the questions into a response unit, and a score counter provides a score at the conclusion of responses to a question. See, e.g., col. 4, lines 8-19. Successful contestants may receive prizes, coupons, or other rewards. See, e.g., col. 16, lines 39-44.

**No Teaching of Storing First and Second Sets of Questions in Computer**

The limitations at issue are expressed in claim 1, for example, as “storing in a computer system a first set of trivia questions relating to advertising content;” and “additionally storing in said computer system a second set of trivia questions relating to show content.

At paragraph 3 of the present Office Action, the Examiner continues to cite column 44, line 55, to column 45, line 5, of Von Kohorn as disclosing storage in a computer system of the first set of questions, and cites column 2, lines 42-59, of Von Kohorn as disclosing storage in a computer system of the second set of questions. While Von Kohorn discloses storage of data entered by a respondent, i.e., a response, in a computer system, he fails to teach or fairly suggest the storage in a computer system of the claimed two sets of questions. Applicants see nothing in the cited portions, or elsewhere in Von Kohorn, that teaches or fairly suggests storage in a computer system of Applicants’ claimed first and second sets of questions.

In this respect, Von Kohorn states at column 44, lines 55-67, that his questions are either asked by a host or visually posed to the television viewers by displaying the questions on electronic boards or on other display means. Von Kohorn goes on to state that, alternatively the host may silently point to an advertised item of merchandise to insure that participants are paying attention. In each case, the disclosure of Von Kohorn fails to teach or fairly suggest storage in a computer system of first and second sets of trivia questions relating to advertising content and show content, respectively.

**Von Kohorn Does Not Teach Or Suggest Selecting Subsets**

In addition to the above-recited failure of Von Kohorn to disclose storage of first and second sets of questions, Von Kohorn further fails to teach or suggest the selection of subsets

of each of those sets to ask a member. In this respect, Applicants' claim 1 recites the following:

...selecting a subset of said first set of trivia questions and a subset of said second set of trivia questions to ask a member...

Independent claims 12, 14 and 15 include similar limitations.

Von Kohorn fails to teach or fairly suggest selecting a subset of the first and second sets of trivia questions to ask a member. While the Examiner cites FIG. 28 as disclosing Applicants' claimed "selecting a subset..." element, Applicants disagree. FIG. 28 relates to selection of a shopper's area of interest, and fails to teach or fairly suggest selecting a subset of first trivia questions related to show content and a subset of second trivia questions relating to advertising content to ask a member. To the contrary, in accordance with the description of FIG. 28 at column 88, lines 58-59, "program material including questions and product listings are televised," which would require that viewers receive all questions. At column 44, lines 55-67, he states further that questions are either asked by a television host or visually posed to the television viewers, which would also require that such television viewers receive all questions. This is inconsistent with Applicants' claimed step of selecting a subset of the first and second sets of trivia questions to ask a member.

#### **Non-Obviousness Over Von Kohorn**

Claims 6-7, 9, and 16-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Von Kohorn. This rejection is respectfully traversed in its entirety.

The above arguments that Von Kohorn fails to teach or suggest limitations set forth in Applicants' independent claims are incorporated herein in response to the § 103 rejection and will not be repeated here. Additionally, patentable features of claims 6-7, 9 and 16-24 are set forth below.

Claim 6 requires that the broadcast comprises a display of multimedia content via an internet connection and claim 7 requires that members' responses to subsets of trivia questions be received via an internet connection. Applicants agree with the Examiner that the internet was well known as of the July 31, 2000 priority date of the instant application. However, Applicants do take issue with the assertion that such knowledge in combination with Von Kohorn's disclosure at column 7, lines 11-34 suggests these elements. Von Kohorn discloses therein a "network of broadcast stations," not a network connection comprising an internet connection as claimed. Replacing a "network of broadcast stations" with an internet connection was not well known in the art at the time of the invention or more than one year prior to Applicants' filing date. Further, with respect to claim 7, Von Kohorn's disclosed "network of broadcast stations" fails to teach or suggest using an internet connection to receive members' responses.

Regarding claims 16-19 and 20-24, the Examiner acknowledges that Von Kohorn fails to teach Applicants' claimed step of creating a report indicative of effectiveness of advertising content based at least in part on member's responses to first and second sets of trivia questions relating to advertising content and show content, respectively. While the Examiner cites column 44, line 55, to column 45, line 5, and column 135, lines 5-27, of Von Kohorn, in combination with official notice, as suggesting these elements, Applicants disagree. Nothing in

the cited portions or elsewhere in Von Kohorn discloses measuring the effectiveness of advertising based upon members' responses to first and second sets of trivia questions relating to advertising content and show content, respectively. Thus, Von Kohorn, even when combined with the official notice taken by the Examiner, does not teach or suggest the invention of claims 16-19 and 20-24. Further, as discussed in detail above with respect to the § 102 rejections, Von Kohorn fails to teach or suggest storing in a computer system first and second sets of trivia questions relating to advertising content and show content, respectively, as required by independent claims 16 and 20. Applicant further notes that claim 21 has been amended to recite using the responses to a set of trivia questions to create a report quantifying at least one broadcast performance factor comprising at least one of recall, understanding, and likeability. Such quantification is not taught or suggested by Von Kohorn or the official notice taken by the Examiner.

#### **Response to Arguments**

Applicants have carefully reviewed the Examiner's response to Applicants' prior arguments, and fully appreciate the same. Much progress has been made throughout prosecution of this application. However, it is Applicants' view that there is still some misunderstanding between Applicants and the Examiner, and this is addressed below.

The main issue lies in the reading of the elements in the independent claims which require storage of first and second sets of trivia questions, the first set being directed to show content and the second set being directed to advertising content, and then selecting subsets of those trivia questions to ask a member. The Examiner argues that the claimed first set is met

by Von Kohorn's disclosure at col. 44, line 55 to col. 45, line 5, and argues that the claimed second set is met by Von Kohorn's disclosure at col. 2, lines 42-59. The Examiner further asserts that the claimed selection of a subset of questions to ask the member is met by Von Kohorn's disclosure at FIG. 28 and col. 16, line 39.

While Applicants disagree with the Examiner's reading summarized above, assume for the purposes of argument that this is a fair reading.

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, **arranged as in the claim**. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick, 221 USPQ 481, 485 (Fed. Cir. 1984).

Von Kohorn fails to teach or suggest storing in a computer system a first set of trivia questions relating to advertising content **and additionally** storing in the computer system a second set of trivia questions relating to show content, and then selecting a subset of the first set of trivia questions **and** a subset of the second set of trivia questions **to ask a member**.

While Applicants appreciate that Von Kohorn (1) teaches at col. 2, lines 42-59, the transmission of signals representing questions and responses in connection with a broadcast, (2) teaches at col. 44, lines 55 et seq. that a host or off-camera announcer can "direct the attention of the audience to the fact that the next question will deal with an aspect or feature of a product or service," and (3) teaches at col. 16, line 39 that sub-questions may be derived from a parent question, such teachings completely fail to teach or suggest the Applicants' claimed arrangement recited above.

Under Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick, therefore, Von Kohorn cannot anticipate the claimed arrangement. Furthermore, while obviousness of the

subject independent claims is not at issue, Von Kohorn also would not render obvious the claimed arrangement because of the lack of a teaching, suggestion or motivation for the claimed arrangement in the prior art. See, e.g., Crown Operations Intern., Ltd. v. Solutia Inc., 289 F.3d 1367, 1376 (Fed. Cir. 2002). See also ATD Corp. v. Lydall, Inc., 159 F.3d 534, 546 (Fed. Cir. 1998) (“Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention”).

#### **Conclusion as to Patentability Over Von Kohorn**

In view of all of the above, Von Kohorn clearly fails to teach or suggest specific elements and the arrangement of those elements as set forth in claims 1-5, 8, 10-15 and 26, and therefore fails to anticipate these claims. Thus, Applicants’ invention is patentable over Von Kohorn, and the anticipation rejection under § 102 should be withdrawn.

With respect to the obviousness rejection, it has been shown above that claims 6-7, 9, and 16-24 include limitations not taught or suggested by Von Kohorn. It is well established that, in order to show obviousness, all limitations must be taught or suggested by the prior art. In Re Boyka, 180 U.S.P.Q. 580, 490 F.2d 981 (CCPA 1974); MPEP § 2143.03. It is error to ignore specific limitations distinguishing over the references. In Re Boe, 184 U.S.P.Q. 38, 505 F.2d 1297 (CCPA 1974); In Re Saether, 181 U.S.P.Q. 36, 492 F.2d 849 (CCPA 1974); In Re Glass, 176 U.S.P.Q. 489, 472 F.2d 1388 (CCPA 1973). It is therefore requested that the § 103 rejection of claims 6-7, 9, and 16-24 over Von Kohorn be withdrawn.

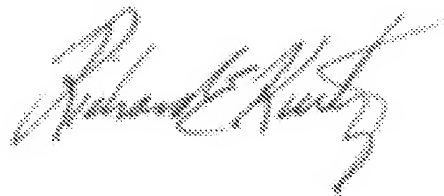


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Having responded to all objections and rejections, it is submitted that pending claims 1-24 and 26 are allowable and the application is in condition for allowance. Notice to that effect is respectfully solicited.

In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of the application, he is courteously requested to contact Applicants' undersigned representative.

Respectfully submitted,



Date: February 12, 2007

By: \_\_\_\_\_

Richard E. Kurtz, II  
Registration No. 33,319  
Telephone No. (703) 749-1300  
Facsimile No. (703) 749-1301

Correspondence Address  
GREENBERG TRAURIG  
1750 Tyson's Boulevard  
Suite 1200  
McLean, VA 22102